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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/816,556	03/23/2001	Brian W. Bramlett	5038-77	7122

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EXAMINER

VU, KIEU D

ART UNIT	PAPER NUMBER
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2173

DATE MAILED: 02/23/2004

9

Please find below and/or attached an Office communication concerning this application or proceeding.

13

Office Action Summary

Application No.

09/816,556

Applicant(s)

BRAMLETT, BRIAN W.

Examiner

Kieu D Vu

Art Unit

2173

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-6, 8-16, 18-26, 28-39 are rejected under 35 U.S.C. 102(e) as being anticipated by Nuovo et al ("Nuovo", USP 6097964).

Regarding claim 1, Nuovo teaches selection device 1 comprising a display 3 designed to present a selection; and a selector 10 operable in two axes, a first axis (rotation axis of the roller body) for changing the selection and a second axis for acceptance (press the roller) of the selection (line 63 of page 5 to line 3 of page 6), the selector operable in two directions on each of the axis and the second axis (rotation axis and pressing axis).

Regarding claim 2, Nuovo teaches the first axis of the selector is a rotation axis (revolve the roller, col 5, line 67).

Regarding claim 3, Nuovo teaches that the display changes in relation to the rotation of the selector around the rotation axis (Fig. 10).

Regarding claim 4, Nuovo teaches that the selection opens a sub menu for further selection with the selection device (col 11, lines 22-24).

Regarding claim 5, Nuovo teaches the selection is designed to scroll across the display (68 in Fig. 10).

Regarding claim 6, Nuovo teaches comprising interconnection means for interconnecting the selection device with a second device to exchange data (phone network device, col 5, lines 24-29)

Regarding claims 8-9, Nuovo teaches that the interconnection means includes a wireless transmitter and wireless receiver (col 5, lines 24-29).

Regarding claims 10 and 20, Nuovo teaches a method for using a selection device 10, the method comprising navigating a menu (Fig. 10) using the selection device, the menu including at least one selection, the selection device operable in two independent axes, a first axis (rotation axis of the roller body) for changing a selection and a second axis for acceptance or rejection of the selection (col 11, lines 22-24); the selector operable in two directions on each of the axis and the second axis (rotation axis and pressing axis), displaying the selection in a display (Fig. 10); and performing an operation responsive to the selection (Redial 72).

Regarding claims 11 and 21, Nuovo teaches the navigating a menu includes changing the selection as the selection device is operated along the first axis (Scroll the list).

Regarding claims 12 and 22, Nuovo teaches the including accepting the selection as the selection device is operated along the second axis (depress the roller body).

Regarding claims 13 and 23, Nuovo teaches updating the display as the selection changes (changing the highlight upon changing the selection in Fig. 10).

Regarding claims 14 and 24, Nuovo teaches the scrolling the display in an up/down direction as the selection device is operated along the first axis (col 11, lines 22-24).

Regarding claims 15 and 25, Nuovo teaches scrolling the display in a left or right direction (move cursor between Names and Menu in Fig. 10).

Regarding claims 16 and 26, Nuovo teaches communicating with a second device (phone network device, col 5, lines 24-29).

Regarding claims 18 and 28, Nuovo teaches the including wirelessly communicating with a second device (col 5, lines 24-29).

Regarding claims 19 and 29, Nuovo teaches the menu includes at least two levels (menu and menu structure; and performing an operation includes opening a second level of the menu (col 11, lines 22-35).

Regarding claims 30, Nuovo teaches the second axis is a translation axis (front-to-back motion of the navigation key).

Regarding claim 31, Nuovo teaches that rotation axis is operative to rotate around the translation axis when the user rolls the navigation key 10, the surface of roller body 20 rolls on rotation axis which rotates around the front-to-back axis (the translation axis).

Regarding claims 32 and 36, Nuovo teaches the changing the selection includes changing the selection as the selection device is rotated along the first axis (when the navigation keys is being rotated along the rotation axis, the selection rolls up or down).

Regarding claims 33-34 and 37-38, Nuovo teaches that the navigating a menu further includes accepting the selection as the selection device is operated and

Art Unit: 2173

translated along the second axis (an item on menu is selected as the navigation key moves along the front-to-back axis).

Regarding claims 35 and 39, Nuovo teaches the accepting the selection as the selection device is translated along the first axis (col 5, lines 4-17).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 7, 17, and 17 rejected under 35 U.S.C. 103(a) as being unpatentable over Nuovo and Jasinski et al ("Jasinski", USP 5063289).

Regarding claims 7, 17, and 27, Nuovo does not teach the cable to connect the device to a second device. However, such feature is known in the art as taught by Jasinski. Jasinski teaches a combined mouse and trackball which comprises the cable 33 to connect the device with a computer (col 2, lines 66-67). It would have been obvious to one of ordinary skill in the art, having the teaching of Nuovo and Jasinski before him at the time the invention was made, to modify the device taught by Nuovo to include the cable connection taught by Jasinski with the motivation being to enable the data transmission between the two devices.

5. Applicant's arguments filed 11/28/03 have been fully considered but they are not persuasive.

In response to Applicant's argument "while the navigation key of Nuovo may be rolled either up or down, or it may be pushed: it may not be pull", it is noted that the pulling ability that the Applicant relies to is not presented in the claim.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the pulling ability) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

It is clear that Nuovo does teach that the selection device operates in two different directions since the first direction, in Nuovo reference, is rotating direction on the axis of rotation and the second direction, in Nuovo, is pressing direction on front-to-back axis.

Applicant's argument "[a]s these axes are different, the rotation axis of the navigation key in Nuovo does not rotate around the translation axis" is not persuasive since it is clear that when the user rolls the navigation key 10, the surface of roller body 20 rolls on rotation axis which rotates around the front-to-back axis (the translation axis).

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

Art Unit: 2173

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kieu D. Vu whose telephone number is (703-605-1232).

The examiner can normally be reached on Mon - Thu from 7:00AM to 3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca, can be reached on (703- 308-3116).

The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

(703)-872-9326


and / or:

(703)-746-5639 (use this FAX #, only after approval by Examiner, for "INFORMAL" or "DRAFT" communication. Examiners may request that a formal paper / amendment be faxed directly to them on occasions)

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703-305-3900).

Kieu D. Vu

02/19/04


RAYMOND J. BAYERL
PRIMARY EXAMINER
ART UNIT 2173